

Remarks

Claim 1 has been amended by substituting chemokine receptor-2 for CCR-2. Claims 2-4 are unchanged. Claim 5 has been added and is the species that was described as provisionally elected in the Response to the Restriction Requirement. Claim 5 describes the compound represented in Claim 4 and also as Compound B on page 280, without stereochemistry.

Applicants have addressed the rejections in the Office Action, as explained below.

Rejections under 35 U.S.C. § 112

The examiner has rejected the claims under 35 U.S.C. § 112 second paragraph for not defining CCR-2. This has been overcome by replacing "CCR-2" with the full name of the receptor (chemokine receptor-2) as suggested by the examiner at the bottom of page 2 of the Office Action. The full name for CCR-2 is supported on page 2, lines 23 and 24.

The examiner has rejected the claims under 35 U.S.C. § 112 first paragraph as lacking enablement for prevention of neuropathic pain. The examiner bases the rejection on the statement on page 270 of the application that "treatment" refers both to the treatment and to the prevention or prophylactic therapy of the conditions mentioned in the application, even though the claims are literally directed only to treating neuropathic pain. The statement on page 270 is not meant to be a new definition of treatment, but merely indicates that treatment can also be given a broader interpretation for reading the specification, because the compounds may also be useful for prevention of neuropathic pain. If the word "treatment" in the claims was actually meant to include both treatment (in its usual sense) and prevention, then there would be no simple way to actually claim treatment only.

The claim language is more clearly explained on pages 2 and 3 in the Summary of the Invention and Detailed Description of the Invention. It is stated at the top of page 3 (lines 7 and 8) that "CCR-2 antagonists treat, ameliorate, and/or prevent neuropathic pain." By using and/or, it is clear that "treat", "ameliorate" and "prevent" each have separate meanings. Otherwise "and/or" does not make logical sense.

Therefore, the word "treating" in the claims means only treating. The claims do not include prevention of neuropathic pain. The rejection therefore is not correct and should be withdrawn.

Rejection under 35 U.S.C. § 102 (e)

The claims are rejected under 35 U.S.C. § 102 (e) over Jiao (US Publication 2005/0101628A1). The published application discloses the compound claimed in Claims 2-5 of the current application, and also states at the top of page 8, column 2, that inhibitors of chemokine receptor function may be useful in the treatment of "...neuropathic and inflammatory pain." This is part of a long list of potential uses for CCR-2 antagonists that begins at paragraph 250 in the middle of column 1 as a general statement that the compounds can be used generally for "diseases and conditions associated with inflammation and infections" and then proceeds to the middle of the next column naming diseases and conditions that may be associated with inflammation and infection. This is not a clear statement that CCR-2 antagonists can be used in the treatment of neuropathic pain, as is required for a novelty-destroying reference. Furthermore, as the examiner points out, the pain described in Jiao is always associated with inflammation.

The examiner also cites US Patent 5,502,058 (Mayer, et al) for support that pains associated with inflammation can be considered to be neuropathic pains. This is irrelevant in this case since Mayer apparently is being offered in combination with Jiao to support a rejection for lack of novelty under 35 U.S.C. § 102 (e). Combining references to support a novelty rejection is not appropriate.

Therefore, the rejection under 35 U.S.C. § 102 (e) should be withdrawn.

Double Patenting

The examiner also has rejected the claims for obviousness-type double patenting over Claims 26-27 of US Publication 2005/0101628A1. The cited publication has only 5 Claims, all of which are directed to compounds. The rejection is incorrect and should be withdrawn.

Conclusion

All of the rejections have been addressed and overcome. It is respectfully submitted that the claims are in condition for allowance. Such action is earnestly solicited.

If the examiner wishes to discuss any matter with respect to this application, she is invited to telephone the undersigned attorney.

Respectfully submitted,

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